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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,641	02/05/2001	Adrian P. Wise	100419(EP)USD1X1CID8 PDDD	6596
22887	7590	10/01/2003	EXAMINER NGUYEN, DUSTIN	
DISCOVISION ASSOCIATES INTELLECTUAL PROPERTY DEVELOPMENT 2355 MAIN STREET, SUITE 200 IRVINE, CA 92614			ART UNIT 2154	PAPER NUMBER

DATE MAILED: 10/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/776,641

Applicant(s)

WISE ET AL.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☒ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. 09/307,239 Copy of EP 923066 38,8 2  
GB 9405914.4
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Claims 1-6 are presented for consideration.

#### ***Response to Amendment***

2. As per remarks, Applicants request a correction of the record for the Office Action mailed on April 24<sup>th</sup>, 2003 to response to the filing of the Application on February 5<sup>th</sup>, 2001. According to our record, the Office had received a request from Applicants for Change of Address on October 9<sup>th</sup>, 2002, the last Office Action was mailed out based on this date.

3. As per remarks, Applicants submit a Terminal Disclaimer for the purpose of overcoming the double patenting rejection of U.S. Patent 6,263,422. Claims 1-6 of current application are rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1-10 of Patent No. 6,122,315, not Patent No 6,263,422. Therefore, the terminal disclaimer is not effective to overcome the double patenting rejection.

4. As per remarks, Applicants request an acknowledge receipt of Certified copies of foreign documents. According to our record, Certified copies of priority documents EP 92306038.8, and GB 9405914.4 had been received in the parent application 09/307,239, not the Certified copy of document GB 9504046.5, Examiner requests Applicants to resubmit the missing Certified copy of document GB 9504046.5.

5. As per remarks, Applicants argue that (1) Horvath does not disclose a “sequence of pipeline stages” nor does it disclose a pipeline stage which is “reconfigurable to operate according to ... different standards”..

6. As to point (1), the limitation is rejected as mentioned in the previous Office Action which encloses below. Furthermore, Horvath discloses a process-pipeline architecture [ col 1, lines 54-61 ], and stages to process different standards [ e.g. MPEG, JPEG ] [ col 1, lines 33-41; and col 10, lines 17-37 ]. Also, Horvath discloses processing circuitry which is used to process block of data according with the information expressed by the processing control unit [ col 2, lines 19-54 ].

7. As per remarks, Applicants argue that (2) Horvath does not disclose a “pipeline stage” including a “state machine”.

8. As to point (2), Horvath discloses a Local State Machine (LSM) is interposed between adjacent, serially coupled routines or functions [ col 1, lines 54-61 ].

9. As per remarks, Applicants argue (3) the reference Ueda is silent as to processing image processing blocks..

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10. As to point (3), the reference Ueda discloses a sequence of pipelines stages as described in Figure 4. The claimed limitation does not mention about processing of image processing blocks. Also, even though, Horvath does not specifically disclose a sequence of pipeline stages, but Horvath does mention about a process-pipeline architecture [ col 1, lines 55-57; and can be viewed in Patent No 5,289,577 as mentioned in Cross Reference disclosed by Horvath reference ].

11. As per remarks, Applicants argue (4) Horvath does not disclose a “token” as “interactive interfacing messenger package for control and/or data functions”.

12. As to point (4), Horvath discloses block processing control information [ col 2, lines 21-22 and lines 45-55 ].

13. As per remarks, Applicants argue (5) Ueda does not discloses an “inactive state”.

14. As to point (5), Ueda discloses the “inactive state” as mentioned in the previous Office Action.

15. As per remarks, Applicants argue (6) Schwartz operates on streams of data, in contrast to Horvath which operates on image blocks.

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16. As to point (6), Schwartz discloses the system operating on frame of images, motion picture, which is similar to the data structures of Horvath as well as the present invention [ col 9, lines 44-46; and col 17, lines 46-57 ].

17. Applicant's arguments filed 07/08/2003 have been fully considered but they are not persuasive.

#### ***Oath/Declaration***

18. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It is claiming the domestic priority of application 08/382952 which is not the same application as mentioned in the disclosure as 08/382958 ( Amendment filed on 02/12/2002 ).

#### ***Double Patenting***

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of patent No. 6122315 [ hereinafter '315 patent ]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

As per claims 1-6, the '422 patent contains the subject matter claimed in the instant application. Both are claiming common subject matter, as follows:

A pipeline system comprising:

a sequence of pipeline stages ...;

the at least one of the pipeline stages ...;

the at least one of the pipeline stages ...; and

wherein the at least one of the pipeline stages ...

The claims of '315 patent does not specifically state a state machine as described in the claims 1-6 of instant application but it would have been obvious to a person skill in the art to recognize that the two claims are similar because the state machine is implemented as raster process as described in the specification of '315 patent.

### ***Claim Rejections - 35 USC § 103***

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvath et al. [ US Patent No 5450599 ], in view of Ueda et al. [ US Patent No 5148529 ].

23. As per claim 1, Horvath discloses the invention substantially as claimed including a pipeline system for decoding a data stream of data having portions encoded according to different standards comprising:

at least one of the pipeline stages being reconfigurable to operate according to the different standards [ col 2, lines 45-55; and col 9, lines 13-38 ].

the at least one of the pipeline stages including processing circuitry [ 18, Figure 1 ] with an active state which is entered when the data received by the at least one of the pipeline stages has a predetermined activation pattern [ col 4, lines 61-col 5, lines 30 ], the predetermined activation pattern corresponding to one of the different standards [ col 6, lines 1-16 ];

the at least one of the pipeline stages including a state machine having a current state and a previous state [ col 1, lines 59-61; and col 5, lines 15-30 ]; and

Horvath does not disclose

a sequence of pipeline stages;

wherein the at least one of the pipeline stages is activated upon recognition of the predetermined activation pattern only upon a predetermined transition from the previous state to the current state.



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Ueda discloses

a sequence of pipeline stages [ Figure 4 ];

wherein the at least one of the pipeline stages is activated upon recognition of the predetermined activation pattern only upon a predetermined transition from the previous state to the current state [ col 17, lines 11-33 ].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Horvath and Ueda because Ueda's teaching would allow the system to perform on different standard without adding additional hardware.

24. As per claim 2, Horvath does not disclose the processing circuitry has an inactive state, in which the at least one of the pipeline stages passes data to a following pipeline stage without processing. Ueda discloses the processing circuitry has an inactive state, in which the at least one of the pipeline stages passes data to a following pipeline stage without processing [ Abstract ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Horvath and Ueda because Ueda's teaching would allow the system to dynamically decode data stream of different standards.

25. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvath et al. [ US Patent No 5450599 ], in view of Ueda et al. [ US Patent No 5148529 ], and further in view of Schwartz [ US Patent No 4682248 ].

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26. As per claim 3, Horvath and Ueda do not disclose the sequence of pipeline stages includes at least one spatial decoder stage. Schwartz discloses the sequence of pipeline stages includes at least one spatial decoder stage [ col 20, lines 1-23 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Horvath, Ueda and Schwartz because Schwartz's teaching would allow the system to perform on different standard without adding additional hardware.

27. As per claim 4, Horvath and Ueda do not disclose the sequence of pipeline stages includes at least one temporal decoder stage. Schwartz discloses the sequence of pipeline stages includes at least one temporal decoder stage [col 20, lines 1-23 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Horvath, Ueda and Schwartz because Schwartz's teaching would allow the system to perform on different standard without adding additional hardware.

28. As per claim 5, Horvath and Ueda do not disclose the at least one of the pipeline stages is a spatial decoder stage. Schwartz discloses the at least one of the pipeline stages is a spatial decoder stage [col 20, lines 1-23 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Horvath, Ueda and Schwartz because Schwartz's teaching would allow the system to perform on different standard without adding additional hardware.

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29. As per claim 6, Horvath and Ueda do not disclose the at least one of the pipeline stages is a temporal decoder stage. Schwartz discloses the at least one of the pipeline stages is a temporal decoder stage [col 20, lines 1-23 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Horvath, Ueda and Schwartz because Schwartz's teaching would allow the system to perform on different standard without adding additional hardware.

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703) 305-9678.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen

  
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